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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,836	04/17/2004	Wade C. Horton	HORTON-PA-I	8772

7590 10/15/2007
OBER / KALER
c/o Royal W. Craig
120 East Baltimore Street
Baltimore, MD 21202

EXAMINER

FIGUEROA, ADRIANA

ART UNIT	PAPER NUMBER
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3633

MAIL DATE	DELIVERY MODE
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10/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/825,836

Applicant(s)

HORTON, WADE C.

Examiner

Adriana Figueroa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,7,9-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7,9-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal brief filed on 08/31/2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Objections

2. Claims 4, 9, 10 and 14 are objected to because of the following informalities:

Claim 4 in line 2, the phrase "away from structure" is incomplete, the correct phrase is "away from the structure". Appropriate correction is required.

Claim 9 recites the limitation "said structure is a ceiling, wall or floor"; claim 10 recites the limitation "said frame is constructed of wood, metal or plastic material"; claim 14 recites the limitation "said object-shape is a star, flower or house". This is an

improper form of a Markush type claim. See MPEP § 803.02 [R-5] for information about Markush type claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6, 7, 9, 10, 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelmelis (US 6,474,846).

Regarding claim 1, Kelmelis discloses an accent frame (21, 31) for framing an article inset (17) within a cutout (14) of a structure (13), said inset article including a finishing ring (41) for providing a transition from said article to said structure; said accent frame comprising a rigid thin sheet of material (19, 31) larger in size than the finishing ring (41), said rigid thin sheet having an outer edge (o) defining an object-shape and a convex inner edge defining an aperture having a lip (23) for proper positioning with said cutout, whereby said accent frame (19, 31) serves as an aesthetically pleasing backdrop to said finishing ring (41) and serves to cover up any imperfections in the finish or cut of the surrounding structure, (annotated Figure 1).

Kelmelis does not disclose said cutout comprising slots and said finishing ring comprising expandable tension clips for insertion through said aperture and said slots thereby securing said frame in place between said finishing ring and about the cutout

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and against the structure. However, Kelmelis discloses a cutout (14) comprising tension clips (15) and said finishing ring (41) comprising slots (53). Therefore, it would have been an obvious matter of design choice to modify the cutout to have slots and the finishing ring to have the tension clips since such modification would have involved a mere reversal of parts. *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955). In addition, Kelmelis discloses that the clips (15) can be mounted to other structures, (Column 3, Lines 28-30).

The modified assembly of Kelmelis would be obviously capable of securing said frame in place between said finishing ring and about the cutout and against the structure.

Regarding claim 2, Kelmelis discloses a decorative outer edge (o), (annotated Figure 1).

Regarding claim 3, Kelmelis discloses said accent frame (21, 31) is seated flush with said structure (13), (Figure 5).

Regarding claim 4, Kelmelis discloses said frame (21, 31) flares slightly away from the structure (13), (Figure 5). The phrase "to provide an aesthetically pleasing depth or texture to the frame" is considered intended use and is given little patentable weight.

Regarding claim 6, Kelmelis does not specifically disclose said thin sheet of material is approximately 1 mm thick. However, it would have been a matter of design choice to make the thin sheet approximately 1 mm thick, since such a modification would have involved a mere change in the size of the component and would provide a

light weight sheet. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claim 7, Kelmelis discloses said article is a recessed lighting fixture (17), (Figure 1).

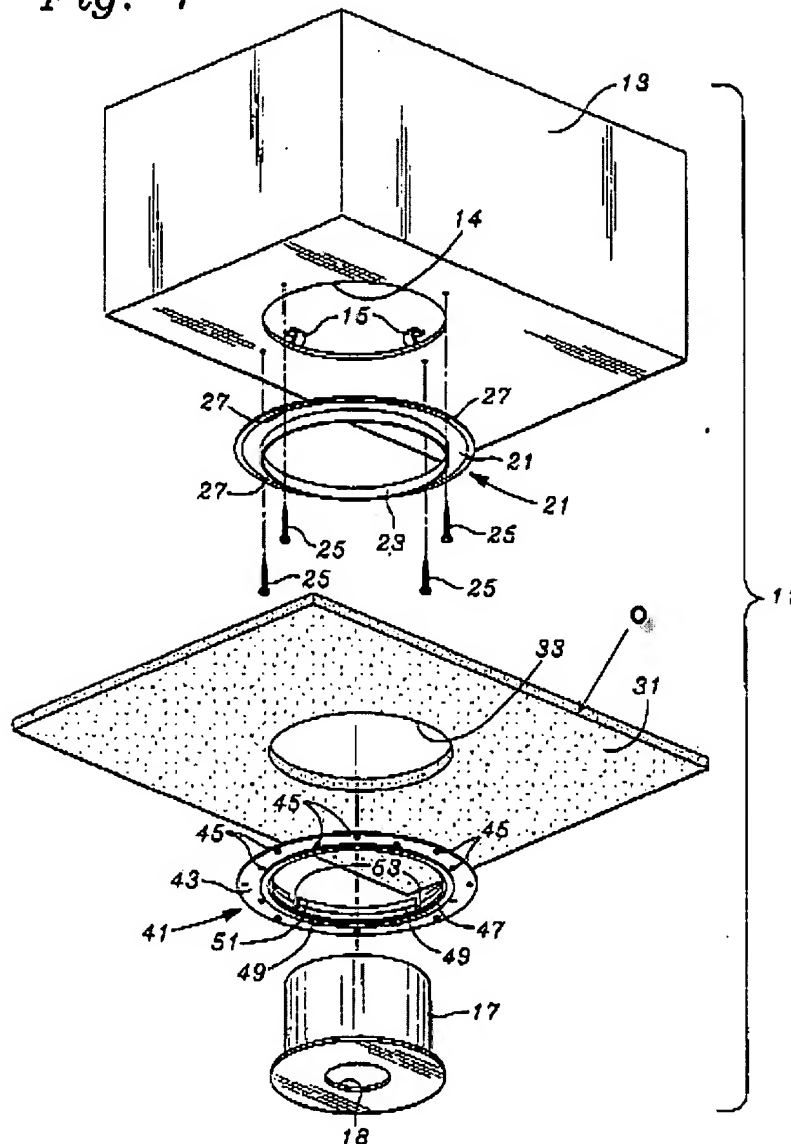
Regarding claim 9, Kelmelis discloses said structure (13) is a ceiling, (Figure 1).

Regarding claim 10, Kelmelis does not disclose said frame is constructed of wood, metal or plastic materials. However, it would have been a matter of design choice to construct the frame of wood, metal or plastic materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 13, Kelmelis frame is obviously capable of being decorative and covers up any imperfections in the edges of the cutout not covered by the finishing ring.

Regarding claim 14, Kelmelis does not disclose the object-shape being a star, flower or a house. However, it would have been an obvious matter of design choice to modify the object of Kelmelis to have a shape of a star, flower or a house, since such a modification would have involved a mere change in the shape of the component and would provide different decorative motives. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Fig. 1



4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelmelis (US 6,474,846) in view of Gretz (US 6,152,413).

Kelmelis discloses as discussed above, but does not disclose said frame is formed by injection molding. However, Gretz discloses a frame (10) formed by injection molding (Column 4, Lines 56-60). Therefore, it would have been obvious to a person

having ordinary skill in the arts at the time of the applicant's invention to modify the frame of Kelmelis to be formed by injection molding as taught by Gretz in order to provide a stronger and flexible frame.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Junk (US 3,666,040) teaches an assembly having a frame, finishing ring and a cutout of a structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adriana Figueroa whose telephone number is 571-272-8281. The examiner can normally be reached on Monday-Friday 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/AF/
10/09/2007



RICHARD E. CHILCOT, JR.
SUPERVISORY PATENT EXAMINER